

Serial No. 09/653,735
Attorney Docket No. 65678-0032

REMARKS

I. CLAIMS 8 AND 18-20 CONTAIN PATENTABLE SUBJECT MATTER IN ACCORDANCE WITH SECTION 101.

In the Office Action, claims 8, 10, 11, and 18-20 were rejected under 35 U.S.C. 101 as being directed toward non-statutory subject matter because those claims include the element of a "dealer" as a limitation with respect to the element of a "user." Claims 9-11 were canceled, but the limitations of claim 11 were added to claim 8. No constitutional or statutory provision was cited in support of the proposition that claims cannot include human beings as elements. Moreover, no case law authority or MPEP citation was provided. There is no per se rule against including a user, physician, dealer, or other form of human being as a claim element. See Cardiac Pacemakers, Inc. v. St. Jude Med., Inc., 296 F.3d 1106, 1115 (Fed. Cir. 2002) ("physician" held not be a validating element in the context of a means-plus-function claim because the patent holder previously waived the argument).

Numerous examples of issued patents including such elements can be found on the PTO web site. By way of example, at least 414 patents have issued since 1976 that include a "physician" as a claimed element. That list of 414 patents includes use of the word "physician" in an apparatus or system claim. If at least 414 patents include the claim element of a "physician" then there can be no prohibition against the Applicants' including elements such as an "asset user", "asset owner", "asset supplier" or "maintenance organization."

The potential inclusion of a human being as a claim element is not the same thing as claiming ownership of human being. To claim a system that involves user interaction by "an asset user", "asset owner", "asset supplier" or "maintenance organization" does not constitute a claim directed toward constitutionally banned ownership of a human being. Therefore, claims 8 and 18-20 contain patentable subject matter and are in condition for allowance.

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II. CLAIM REJECTIONS USING KOETHER IN VIEW OF ALBERTSHOFER

In the Office Action, claims 1-20 were rejected under 35 U.S.C. 103(a) as being obvious over U.S. Patent No. 5,875, 430 ("Koether") in view of U.S. Patent No. 6,230,081 ("Albertshofer"). As acknowledged by the Examiner, Koether does not explicitly recite determining a lease rate. Therefore, the Examiner relies on Albertshofer "to determine a leasing rate". However, no such teaching is found in Albertshofer in the sections relied on by the Examiner.

Column 1, lines 55-61 relate to a listing of travel data including the condition of vehicle system components. Similarly, Column 3, lines 31-39 relate to connecting the vehicle to various sensors to capture travel data.

Column 2, lines 36-44 and Column 4, lines 10-26 relate to a total lease amount based either on usage duration of the vehicle or its distance. Travel data is not used to affect the amount of the lease, but is "memorized on the storage medium", the "data possibly being made use of when read into the base station to assist automating vehicle maintenance." Col. 2, lines 38-44. Significantly, charging a lease amount based simply on usage duration or its distance means that the rate amount is fixed as a constant with either usage duration of the vehicle or its distance being the only variable to multiply by the fixed lease rate to obtain the total cost of the lease. There is absolutely no teaching of adjusting the lease rate itself in Albertshofer. In contrast, the claimed invention uses an operating characteristic to set a lease rate acting as a variable, as opposed to a constant as taught in Albertshofer.

The referenced lines at column 6, lines 23-27 teach converting the "data received as to usage of the equipment" and "actual costs of usage can be calculated". Once again, usage duration is the variable as compared to the lease rate itself being a variable based on an operating characteristic of the vehicle. Thus, while Albertshofer teaches adjusting a total lease amount based on "travel data", it is the travel data itself that is the variable as opposed to using the travel data to determine a lease rate acting as a variable, which is then multiplied by at least one other number to determine a total lease amount. Claim 1 has been amended to explicitly recite this

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aspect of a lease rate, but it is respectfully submitted that the claim distinguishes itself from the prior art of record even without this amendment. The remaining independent claims also teach the concept of determining a lease rate for an asset based in part on at least one operating characteristic of the asset. Therefore, they and all of the pending claims are in condition for allowance.

The dependent claims also include limitations that are not taught in the prior art of record. As to claims 2-4, the Examiner takes Official Notice as to claims 2-4, stating that surcharges and the appliance {sic} of surcharges are old and well-known to those of ordinary skill in the art. While surcharges may be old, Applicant is not aware of any prior art wherein the *lease rate* includes a surcharge if the operating characteristic is above a pre-determined threshold and/or a minimum charge if the operating characteristic is below a pre-determined threshold. The same arguments apply to claims 15-17, and claim 19.

Applicant respectfully requests a supporting affidavit or an appropriate reference in the context of claimed invention if the Examiner is going to maintain the rejection of claims 2-4 pursuant to 37 CFR 1.104(d)(2) and MPEP § 2144.04. As the Federal Circuit decision in In re Sang Su Lee, 2002 U.S. App. LEXIS 855 (Fed. Cir. January 18, 2002) makes clear, each and every element of the Applicants' claims must be supported by a prior art citation in order to reject the Applicants' claims.

Dependent claim 5 has been amended to explicitly recite that there are a plurality of operating characteristics used to set the lease rate. No such teaching is shown in the prior art of record. As to claim 6, while Albertshofer arguably does talk about "time of operation within a fixed period of time", once again the operating characteristic is used to adjust the lease rate acting as a variable as opposed to being another number multiplied by a fixed lease rate to determine an overall lease amount. In Albertshofer, the time of operation is multiplied by a pre-determined lease rate set as a constant.

Dependent claim 7 has been amended to more clearly articulate that maintenance information affects lease rate. Independent claim 18 includes the limitation of an asset owner

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establishing the lease rate and analyzing maintenance information as a factor in setting the lease rate. As discussed above, in Albertshofer, data may be used to assist in automating vehicle maintenance. However, there is absolutely no teaching of using maintenance information to affect lease rate. As discussed in the application, the claimed approach provides an incentive for an asset owner to enter into a hybrid lease arrangement because there is better information. Better information reduces risk to the asset owner and increases a willingness to offer a better lease arrangement:

However, if the leasing company and the business both had ready access to the same information concerning the asset, the leasing company may be willing to share an increased portion of the financial risk/reward associated with the asset's usage, maintenance, performance, and the like. With appropriate objective information it may be possible to distribute a portion of the responsibility to other responsible third parties including the asset manufacturer or supplier, and asset maintenance organization. (Page 3, lines 1-6)

Thus, dependent claims 7 and 18, and claims that depend from these two claims are also independently in condition for allowance. Newly added claim 21 depends from claim 1 while newly added dependent claim depends from claim 22, discussed below. Both claims recite that the lease rate is lower if timely maintenance is performed and that the lease rate is higher if the maintenance is untimely. These limitations are not taught in the prior art of record. Thus, they are also in condition for allowance.

Newly added claim 22 depends from claim 1. It recites that the lease rate is based on a hybrid lease arrangement comprising a minimum payment that has to be made if the operating characteristic is below a pre-determined threshold; a usage based-payment if the operating characteristic is above the pre-determined threshold and below a pre-determined maximum threshold; and a penalty or surcharge if the operating characteristic is higher than a pre-determined maximum threshold. There is absolutely no teaching of this type of a hybrid lease arrangement in the prior art of record. Thus, this claim is also independently patentable.

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III. CLAIM REJECTIONS USING KOETHER IN VIEW OF ALBERTSHOFER AND FUTHER IN VIEW OF NGUYEN

The Examiner rejected claim 11 as being unpatentable over Koether, Albertshofer, and further in view of US Patent No. 6,003,808 ("Nguyen"). It is respectfully believed that the Examiner meant to include claim 20 in the rejection using the third reference since it includes very similar limitations. Claim 11 has been incorporated into the limitations of claim 8. Nguyen is totally irrelevant to the two claims. The portions referred to by the Examiner relate to the generation of a warranty claim report for a particular asset. There is absolutely no discussion of reviewing maintenance information for a plurality of assets associated with either an asset supplier or a maintenance organization to evaluate the relationship of the asset owner with either party based on overall maintenance performance, as required by the claims. Thus, they are independently patentable.

IV. CONCLUSION

Claims 1-8, 12-24 are in condition for allowance. If it is believed that any additional fees due with respect to this paper have already been identified in any transmittal accompanying this paper. However, if any additional fees are required in connection with the filing of this paper that are not identified in any accompanying transmittal, permission is given to charge account number 18-0013 in the name of Rader, Fishman and Grauer PLLC.

Respectfully submitted,

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